

AF/2761
JMS

Please type a plus sign (+) inside this box



PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paper Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/579,407	
	Filing Date	05/25/2000	
	First Named Inventor	David L. Bates et al	
	Group Art Unit	2761	
	Examiner Name	C. L. Gilligan	
Total Number of Pages in This Submission		Attorney Docket Number	289.001

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input checked="" type="checkbox"/> Reply Brief to the Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	Return Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s)	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Peter C. Stomma, Reg. No. 36,020 Boyle, Fredrickson, Newholm, Stein & Gratz S.C. 250 East Wisconsin Avenue, Suite 1030 Milwaukee, WI 53202
Signature	
Date	3/21/07

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop - Box Reply Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date: 3/21/2007			
Type or printed name	Christine Kierzek		
Signature		Date	3/21/2007

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:)	<u>Certificate of Mailing</u>
)	I hereby certify that this correspondence
DAVID L. BATES ET AL.)	is being deposited with the United States
)	Postal Services as first class mail
Serial No.: 09/579,407)	in an envelope addressed to: Mail Stop-
)	APPEAL BRIEF – Patent,
Filed: May 25, 2000)	P.O. Box 1450, Alexandria, VA
)	22312-1450 on <u>March 21, 2007</u>
Examiner: C.L. Gilligan)	
)	<u>Christine Kierzek</u>
Art Unit: 2761)	
)	
<i>METHOD FOR GENERATING AN</i>)	<u>Christine Kierzek</u> <u>3/21/2007</u>
<i>INSURANCE QUOTE</i>)	Signature Date

APPELLANT'S REPLY BRIEF

Mail Stop – Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer dated February 27, 2007, Appellant provides this Appellant's Reply Brief. Appellant believes that the Reply Brief is in full conformance with 37 CFR § 41.41, and as such, entry of such Brief is earnestly solicited. Please charge any additional fees to Deposit Account No. 50-1170.

ARGUMENT

Issue I

I. Rejection

The Examiner has rejected claims 1, 3-9, 11, 13-18, 20 and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over Mitcham, U.S. Patent No. 5,537,315 in view of Jones et al., U.S. Patent No. 5,239,462. It is noted that for the reasons outlined in Appellant's Appeal Brief, applicant has not independently argued the merits of the Examiner's rejection claims 2, 10, 12, 19, 21 and 24.

II. Claims 1-10

Claim 1 defines a method of generating an insurance quote for an applicant for a loan from a lender to purchase an item. The method includes the steps of determining the acceptability of the loan and obtaining data from a lender's database. At least a portion of the database is provided to the lender by the applicant in connection with obtaining a loan from the lender. Thereafter, an insurance risk is automatically underwritten for the item intended to be purchased using the loan and the insurance quote is generated utilizing the data obtained from the lender's database. The process does not require any affirmative action by the applicant beyond the preparation of a loan application. The applicant makes no specific request for an insurance quote and does not provide an application for insurance. The applicant is advised of the acceptability of the loan contemporaneously with the insurance quote if the loan has been accepted.

The Examiner suggests that the combination of the Mitcham '315 patent and the Jones et al. '462 patent teaches a method of the present invention. More specifically, the Mitcham '315 patent teaches a method of generating an insurance quote for an individual that comprises the steps of obtaining data from an applicant for insurance and

automatically underwriting an insurance risk from the data obtained from the applicant. As admitted by the Examiner, nothing in the '315 patent contemplates using loan application data to generate an insurance quote, or to provide an insurance quote contemporaneously with a favorable decision on a loan application. In fact, the Mitcham '315 patent is silent as to the subject matter of obtaining a loan.

The Jones et al., '462 patent does not cure the deficiencies of the Mitcham '315 patent. As pointed out by the Examiner, the methodology in Jones defines a method and apparatus for the real time automatic determination of the approval status of a potential borrower of a loan. The methodology in the '462 patent contemplates providing notice regarding a potential borrower's interest in purchasing a product to be sent to an appropriate lead organization, such as a real estate insurance company, to allow for immediate follow-up by the lender or lead organization with the potential borrower. However, Jones does not suggest any action other than the referral to another potential borrower to an insurance company. In the examiner's Answer, it appears that the examiner is equating the phrase "immediate follow-up" with the potential borrower in the '462 patent with various steps required in claim 1, namely:

1. providing an insurance quote to the applicant contemporaneously with a favorable decision on a loan application; and
2. utilizing data obtained from a lender's database to automatically generate the insurance quote. (underlining added).

However, such an interpretation is clearly inconsistent with the specification of the '462 patent and falls grossly short of the disclosure necessary to arrive at the subject matter defined in claim 1.

The mere fact that an insurance company can "follow-up" with an applicant does not imply that the insurance company will follow-up with a "insurance quote" as required by claim 1. In fact, since the lender only provides the insurance company with a notice

regarding the potential's borrower's interest in purchasing a product, the insurance company does not have sufficient information to underwrite insurance risk for the product to be purchased, much less automatically use that data to generate the insurance quote. Further, nothing in the '462 patent contemplates allowing an insurance provider to utilize data obtained from the lender's database to generate the insurance quote. Again, the insurance company is merely provided with a name of a potential customer from a lender along with notice of the approval of a loan request. Hence, even if the insurance company contacted the potential borrower, under the methodology defined in the '462 patent, the borrower would still have to fill out an application and provide the insurance company with the necessary information to generate an insurance quote. As such, nothing in the '462 patent contemplates the insurance company "utilizing the data obtained from the lender's database" to generate the insurance quote as required by claim 1.

As described, the Jones '462 patent contains nothing more than a virtually insignificant mention that notice of a potential borrower's interest in purchasing a product to be sent to an appropriate lead organization, such as a real estate insurance company, to allow for "immediate follow-up" by the lender or lead organization with the potential borrower. It is not reasonable to conclude that one of ordinary skill in the art would combine the disclosure of the '462 patent with the disclosure of the Mitcham '315 patent to arrive at the claimed subject matter. Neither of the cited references shows or suggests a method of generating an insurance quote that includes the step of automatically underwriting an insurance risk of an item that is intended to be purchased using the loan using data obtained from a lender's database or the tying together of the information provided by a potential borrower to generate an insurance quote with the process of obtaining a loan. In short, there is simply not enough disclosure in the '462 patent to make a reasonable combination with the disclosure of the Mitcham '315 patent to arrive at the subject matter as set forth in amended claim 1. Any such combination falls short of

the specific methodology set forth in independent claim 1. Furthermore, any such combination is based upon an impermissible hindsight reconstruction of the references that is obvious only when taking into account the disclosure of the present application.

In view of the foregoing, it is believed that claim 1 defines over the references and is in proper form for allowance. Claims 2-10 depend either directly or indirectly from independent claim 1 and further define a method of generating an insurance quote not shown or suggested in the art. It is believed that claims 2-10 are allowable as depending from an allowable base claim and in view of the subject matter of each claim.

III. Claims 11-19

Claim 11 defines a method for generating an insurance quote for an applicant for a loan. Similar to claim 1, claim 11 requires the steps of determining the acceptability of a loan and automatically underwriting an insurance risk for the item intended to be purchased with the loan proceeds using the data obtained from the lenders database. Claim 11 further requires that an underwriting occur for a plurality of insurance companies. Thereafter, one of the pluralities of insurance companies is selected and an insurance quote is generated for the applicant by the selected insurance company. Finally, the insurance quote is provided to the applicant with the determination of the acceptability of the loan if the loan has been accepted.

As heretofore described with respect to claim 1, neither of the cited references shows or suggests a method of generating an insurance that includes the step of automatically underwriting an insurance risk of an item that is intended to be purchased using data obtained from a lender's database. The process disclosed in the Mitcham '315 patent requires a specific request by an applicant for an insurance quote. The Jones et al. '462 patent merely provides a methodology wherein notice of a potential borrower's

interest in purchasing a product is sent to an appropriate lead organization, such as a real estate insurance company, to allow for "immediate follow-up" by the lender or lead organization with the potential borrower. Contrary to the examiner's opinion, the Jones et al., '462 patent does not teach or suggest that "following up" with a potential borrower means automatically underwriting an insurance risk for the item intended to be purchased with the loan proceeds using the data obtained from the lenders database, as required by claim 11. As such, it is believed that claim 11 defines over the cited references.

Claims 12-19 depend either directly or indirectly from independent claim 11 and further define a method of generating an insurance quote not shown or suggested in the prior art. Applicant believes that claims 12-19 are allowable as depending from an allowable base claim and in view of the subject matter.

IV. Claims 20-24

Referring to claim 20, a method is provided for providing an insurance quote for an applicant for a loan from a lender wherein the loan is intended to fund a purchase from an item. The method includes the step of generating an insurance quote utilizing data provided by an applicant. As heretofore described with respect to claims 1 and 11, nothing in the cited references shows or suggests tying the generation of the insurance quote to information provided to the lender by an applicant in order to obtain a loan. Such a methodology is entirely absent from the cited references. It is believed that independent claim 20 defines over the cited references and is in proper form for allowance.

Claims 21-24 depend either directly or indirectly from independent claim 20 and further define a method not shown or suggested in the prior art. It is believed that claims

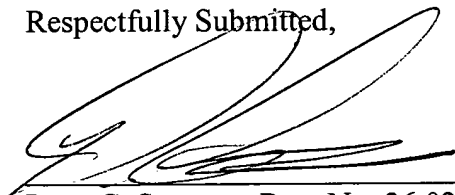
Applicant: David L. Bates et al
Serial No. 09/579,407
Filed: May 25, 2000
Applicant's Reply Brief
Page 7

21-24 are allowable as depending from an allowable base claim and in view of the subject matter of each claim.

CONCLUSION

Contrary to the Examiner's assertions, claims 1-24 define a method of generating an insurance quote not shown or suggested in the prior art. As heretofore described, there are significant differences between Appellant's claimed invention and the cited references which the Examiner has failed to appreciate. These differences provide significant advantages over the methodologies disclosed in the cited references. Consequently, Appellant believes that all of the claims appealed herein, namely, claims 1-24 are in proper form for allowance. As such, Appellant requests that the Board overturn the Examiner's rejection of all of the pending claims, namely, claims 1-24, and pass such claims to allowance.

Respectfully Submitted,


Peter C. Stomma, Reg. No. 36,020

Dated: 3/21/07
Boyle Fredrickson Newholm Stein & Gratz S.C.
250 East Wisconsin Avenue, Suite 1030
Milwaukee, WI 53202
(414) 225-9755
Attorney Docket No.: 289.001